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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,153	07/21/2003	Jens C. Thies	021028-0305107	5213

43569 7590 05/17/2005

MAYER, BROWN, ROWE & MAW LLP  
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WASHINGTON, DC 20006

EXAMINER
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HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/623,153

Applicant(s)

THIES ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 and 18-24 is/are allowed.
- 6) ☒ Claim(s) 15, 17, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 15, 19 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlesinger (3,835,003). With respect to instant claims 15, 19 and 25-26, the composition of Example 4 of Schlesinger anticipates the instant compositions wherein glycidyl methacrylate – allyglycidylether copolymer is the instant glycidyl ether, 3,3-bis (chloromethyl) oxetane is the instant oxetane compound and 2,5-diethoxy-4- (p-tolyl-thio) benzene diazonium hexafluorophosphate is the cationic photoinitiator. While Schlesinger does not disclose the post cure properties of water absorption, flexural modulus, elongation and F<sub>wet</sub>/F<sub>dry</sub> ratio, the examiner holds since the composition of Schlesinger has the required components set forth by applicant then it must inherently be curable to the product with the required properties.

3. Applicant's arguments filed February 28, 2005 have been fully considered but they are not persuasive. Applicant's arguments are as follows:

“With respect to the rejection under 35 U.S.C. 102(b), claim 15 includes “a part” while Schlesinger does not disclose formation of a “part”. Similarly, claim 19 includes an “object” and Schlesinger does not include an “object”. As a result, Schlesinger does not anticipate claims 15 and 19. For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.”

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The examiner states that claims 15 and 19 are drawn to compositions, not objects or parts made from the compositions. The "object" and "part" are limitations on the physical property the cured product of the composition claimed. Thus, the issue is the inherent nature of the compositions of Schlesinger not whether Schlesinger discloses a part or object. The examiner clearly stated that the properties of the compositions set forth for the cured product made from it was not disclosed by Schlesinger, this does not remove the anticipation of the compositions of instant claims 15 and 19 by those of Schlesinger. "A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." The species in that case will anticipate the genus. *In re Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The rejection of claims 15 and 19 stands and rejections of claims 25-26 are added because the composition of Schlesinger inherently possesses the properties set forth wherein such properties are inherent to the composition instead of the result of choice of process variables effecting the properties of an object or part made therefrom. The examiner notes any actinic radiation can be used before post cure. The object can be cured in a clear mold, for example for a long time before "post cure". The intensity of the UV cure is not disclosed leaving the variance of such intensity a process variable that could affect the final

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cured product properties. There is no showing that the curing of glycidyl ether, oxetane and cationic photoinitiator would not inherently yield such a "part" or "object" each time.

4. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 1-14, and 20-24 are allowed.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

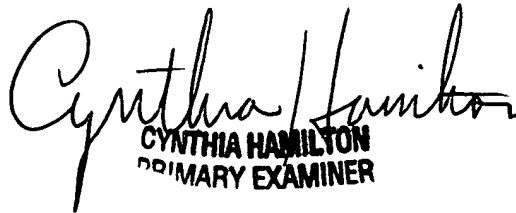
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.*

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*Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).*



CYNTHIA HAMILTON  
PRIMARY EXAMINER

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752

May 12, 2005